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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,998	07/30/2001	Marco Steiger	03630 - P0049B	1503
24126 7590 08/31/2010 ST. ONGE STEWARD JOHNSTON & REENS, LLC 986 BEDFORD STREET STAMFORD, CT 06905-5619				
EXAMINER				
MCDONALD, SHANTESE L				
ART UNIT		PAPER NUMBER		
3723				
MAIL DATE		DELIVERY MODE		
08/31/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/917,998

Applicant(s)

STEIGER ET AL.

Examiner

SHANTESE MCDONALD

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 13-17 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-9, 13-17 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-9, 11, 13-17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. in view of Miller and Atkinson et al.

Fletcher et al. teaches a tool for use with a manually operable material removal apparatus comprising a flat elongated member, 10, having a rearward first section, 12, provided with a hole, 16, which allows the member to be mounted on an output shaft with a fastener having a predetermined thickness, and a forward second section, 8, remote from the first section and including material removing cutting teeth, 2. Fletcher et al. also teaches that cutting teeth are formed by adjoining two straight cutting edge sections at acute angles, (fig. 2). Fletcher et al. also teaches a slot, 24, provided for facilitating removal of cut material, provided in the elongated member between the first and second sections. Fletcher teaches that the elongated member has a substantially constant width at least between the first and second sections, (fig. 1), and the member having a substantially trapeze form outline, (fig. 6a), and the elongated member comprising a third section, disposed between the first and second sections having a first width, at least one of the first and second sections having a second width different from the first width, (fig. 6a). Fletcher teaches all the limitations of the claims except for a

fastener attaching the tool to the output shaft, the elongated member being configured with at least one elongated path that facilitates rearward movement, along the path, of material being cut from the workpiece by the cutting edge, as well as removal of the material being cut, and at least one cutting edge having a first and second end and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, and the acute angle being between 1.4 and 4.6 and 1.5 and 2 degrees, the hole having a shape different from a circle, the hole being a polygon, the elongate member comprising a step intermediate the first and second sections, the step being at least equal to the thickness of the fastener, and having a height being larger than a fastener attached to the output shaft so that a plane substantially normal to the predetermined axis defined by the second section is further from the manually driven apparatus than a plane substantially normal to the predetermined axis defined by the first section whereby the plane defined by the second section is closer to the workpiece during use of the tool than is the plane defined by the first section so that the cutting edge extends in the plane defined by the second section above the hole for fastening the member to the output shaft, Miller teaches elongated member being configured with at least one elongated path that facilitates rearward movement, along the path, of material being cut from the workpiece by the cutting edge, as well as removal of the material being cut, (31,54), and at least one cutting edge having a first and second end and the removal facilitating means comprising recessed portions at the ends of the at least one cutting edge intermediate the first and second sections, (fig. 5B). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to provide the invention of Fisher with the above listed limitations taught by Miller, in order to enhance the material cutting and material removal capabilities. Atkinson et al teaches an elongate member comprising a step a fastener, 119, and a step intermediate the first and second section, so that a plane substantially normal to the predetermined axis defined by the second section is further from the manually driven apparatus than a plane substantially normal to the predetermined axis defined by the first section whereby the plane defined by the second section is closer to the workpiece during use of the tool than is the plane defined by the first section so that the cutting edge extends in the plane defined by the second section, (col.2, lines 15-55, fig. 8). It would have been further obvious to provide the tool of Fisher with a fastener and a step, as taught by Atkinson et al., in order to enhance the versatility and functionality of the tool. It would have been further obvious to make the acute angle of Fletcher between 1.5 and 4.6 and 1.5 and 2 degrees, in order to vary the cutting angles and the hole being a shape different from a circle, the hole being a polygon, the step at least equal to the thickness of the fastener, and having a height being larger than a fastener attached to the output shaft above the hole for fastening the member to the output shaft since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. as modified by Miller and Atkinson et al. in further view of Arntz et al.

Fletcher et al. as modified by Miller and Atkinson et al teaches all the limitations of the claims except for the material removing elements comprising diamonds and corundum. Arntz et al. teaches material removing elements, 35, comprising diamonds and corundum, (col. 4, lines 55-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the material removing elements of Fletcher et al. as modified by Miller and Atkinson et al with diamonds and corundum, as taught by Arntz et al. in order to enhance the elements material removing capabilities, and to make them more durable.

Response to Arguments

Applicant's arguments with respect to claims 1-9,13-17 and 25 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANTESE MCDONALD whose telephone number is (571)272-4486. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.L.M.
August 28, 2010

/Joseph J. Hail, III/

Supervisory Patent Examiner, Art Unit 3723